Remarks

Claims 1 to 37 are pending.

As a first matter, the Examiner requested that applicants reaffirm their election.

In response, applicants hereby affirm their election with traverse Group I, claims 1 to 8, 36, and 37.

The Examiner rejected claim 35 under 35 U.S.C. § 112, first paragraph, as allegedly not enabling.

In response, applicants respectfully traverse the Examiner's rejection. In making this rejection, the Examiner conceded that the specification provides support for a capsule formulation of N-[2-(3,5-bis-trifluoromethylphenyl)ethyl)-2-[4-[3-hydroxypropyl)methylamino]piperidin-1-yl]-N-methyl-2-phenylacetamide alone (which is a NK1-receptor antagonist). The Examiner, however, alleges that the specification provides no support for a combination formulation of N-[2-(3,5-bis-trifluoromethylphenyl)ethyl)-2-[4-[3-hydroxypropyl)methylamino]piperidin-1-yl]-N-methyl-2-phenylacetamide with any anticholinergic compound of formula 1. Applicants respectfully disagree as pages 27 and 28 of the specification disclose capsule formulations that contain a combination of N-[2-(3,5-bis-trifluoromethylphenyl)ethyl)-2-[4-[3-hydroxypropyl)methylamino]piperidin-1-yl]-N-methyl-2-phenylacetamide (the NK1 receptor antagonist) and of a bromide salt of an anticholinergic compound of formula 1 (1'-Bromide). Moreover, on pages 13 and 14 of the specification there are various examples for dosages of the compound of formula 1 (the anticholinergic) and compound of formula 2 (the NK1 receptor antagonist) given that could be administered to a person in need of such treatment. Thus, the subject matter of claim 35 is described in the specification in such a way to enable a person skilled in the art to make use of the invention. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection. If the Examiner maintains the rejection, the Examiner is asked to indicate whether claim 35 limited to asthma, chronic obstructive pulmonary disease (COPD), pulmonary hypertension, or allergic and non-allergic rhinitis (see specification page 10, lines 8 to 14) would be allowable.

The Examiner has also rejected claims 1 to 8 and 35 to 37 under 35 U.S.C. § 103(a) as allegedly obvious over both Meissner *et al.* (U.S. Patent No. 6,706,726) and Pairet *et al.* (U.S. Patent No. 6,620,438), each of which the Examiner alleges is prior art under 35 U.S.C. § 102(e).

In response, applicants state that Meissner *et al.* (U.S. Patent No. 6,706,726), Pairet *et al.* (U.S. Patent No. 6,620,438), and the instant application were commonly owned by Boehringer Ingelheim Pharma GmbH & Co. KG* at the time the invention in the instant application was made and therefore 35 U.S.C. § 103(c) applies. Accordingly, Meissner *et al.* (U.S. Patent No. 6,706,726) and Pairet *et al.* (U.S. Patent No. 6,620,438) are each disqualified as prior art under 35 U.S.C. § 103(c) and the Examiner is respectfully requested to withdraw the rejection.

The Examiner has further rejected claims 1 to 8 and 35 to 37 under 35 U.S.C. § 103(a) as allegedly obvious over Banholzer *et al.* (U.S. Patent No. 5,770,739) and Pairet *et al.* (U.S. Patent No. 6,620,438).

In response, applicants respectfully request clarification of the rejection as the Examiner basis for the rejection discusses Meissner *et al.* (see Office Action, page 8) which is not part of the rejection. Further, Banholzer *et al.* (U.S. Patent No. 5,770,739) involves non-aqueous hydrogen peroxide complexes and its relevance to the rejection is not apparent. In addition, applicants point out that Pairet *et al.* (U.S. Patent No. 6,620,438) has been disqualified as prior art under 35 U.S.C. § 103(c). Accordingly, applicants respectfully request that the Examiner clarify or withdraw the rejection.

The Examiner also provisionally rejected claim 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 12 of copending U.S. Serial No. 11/117,163, in view of Pairet *et al.* (U.S. Patent No. 6,620,438).

---

* Note that the name of the assignee of Pairet *et al.* (U.S. Patent No. 6,620,438) was changed from Boehringer Ingelheim Pharma KG to Boehringer Ingelheim Pharma GmbH & Co. KG and a change of name document executed on February 18, 2003, was recorded at the USPTO on Reel/Frame 015667/0418 on February 18, 2003.

In response, applicants note that the claims of U.S. Serial No. 11/117,163 have not been issued or allowed, and applicants will address any such obviousness issue by argument, amendment, or terminal disclaimer when the Examiner indicates that the instant application contains allowable subject matter and the Examiner maintains the rejection.

The Examiner lastly rejected claims 1 to 8 and 35 to 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 to 9, 11, and 21 to 24 of Meissner *et al.* (U.S. Patent No. 6,706,726) in view of Pairet *et al.* (U.S. Patent No. 6,620,438).

In response, applicants undertake to file a terminal disclaimer when the Examiner indicates that the instant application contains allowable subject matter.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 7, 2005.

Timothy Witkowski

Timothy X. Witkowski
Registration No. 40,232

10-7-2005
Dated

Respectfully submitted,

Timothy Witkowski

Timothy X. Witkowski
Registration No. 40,232
Attorney for Applicants

BOEHRINGER INGELHEIM CORPORATION
Patent Department
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877
Telephone: (203) 798-4310
Facsimile: (203) 798-4408